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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,284

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Kil-soo Jung

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North Star Intellectual Property Law, PC

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EXAMINER

HASAN, SYED Y

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/791,284	Applicant(s) JUNG ET AL.	
	Examiner SYED Y. HASAN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 - 7, 18, 19, 21 - 24 and 27 - 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 - 7, 18 and 31 - 35 is/are rejected.
- 7) ☒ Claim(s) 19, 21 - 24 and 27 - 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/17/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Response to Arguments

1. Applicant's arguments with respect to claims 5 – 7, 18, 19, 21 – 24 and 27 - 35 filed on 12/29/2009 have been considered but are moot in view of the new ground(s) of rejection.

Claims 5 – 7, 18, 19, 21 – 24 and 27 - 35 are allowable provided they overcome the double patent rejection and 35 U.S.C. § 101 for claims 31 – 35.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 5 – 7, 18, 31 and 32 are provisionally rejected on the ground of nonstatutory obviousness- type double patenting as being unpatentable over claims 1 – 8 copending Application No. 10/921,256. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in claims 1 - 8 of copending Application No. 10/921,256, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that claims 1 - 8 of copending Application No. 10/921,256, would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the copending application.

With regard to claim 5 and 31, Applicant's attention is directed to claim 1 and 5 of the copending Application No. 10/921,256.

With regard to claims 6, Applicant's attention is directed to claims 2, 6 and 8 of copending Application No. 10/921,256.

With regard to claim 7, Applicant's attention is directed to claims 3, 6 and 8 of the copending Application No. 10/921,256

With regard to claim 18 and 32, Applicant's attention is directed to claims 2 and 3 of the copending Application No. 10/921,256

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 5 - 7 and 31 are provisionally rejected on the ground of nonstatutory obviousness- type double patenting as being unpatentable over claims 1, 3, 6 - 7, of

copending Application No. 11/435,872. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in claims 1, 3, 6 - 7, of copending Application No. 11/435,872, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that claims 1, 3, 6 - 7, of copending Application No. 11/435,872, would be able to perform the functions of the claimed limitations of the present Application.

With regard to claims 5 and 31, the feature of using a second clock decoding the depacketized sub audio data is present in claims 1 and 3 of the copending Application No. 11/435,872.

With regard to claim 6, the feature of the arrival time clock is present in claim 6 – 7 of the copending Application No. 11/435,872.

With regard to claims 7, Applicant's attention is directed to claim 6 - 7 of copending Application 11/435,872.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Double – patent rejection is being maintained until the rejection of the present application is resolved.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility “(Official Gazette notice of 22 November 2005), Annex

IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim 31 - 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 31 - 35 define "recording medium" with descriptive material. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") while embodied on a tangible computer readable medium, recording medium embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory class of §101. Rather, "medium" is a form of energy, in the absence of any physical structure or tangible material.

Examiner recommends either cancelling the claim or adding language to the claim that makes this claim statutory, e.g. "non-transitory recording medium"

This claim language needs to be supported by the specification.

Allowable Subject Matter

6. Claims 5 – 7, 18 and 31 - 35 would be allowable if the double patent rejection for claims 5 – 7, 18, 31 and 32 and 35 U.S.C. § 101 rejection for claims 31 - 35 are overcome.

Claims 19, 21 – 24 and 27 - 30 are objected as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and amended to overcome the rejection(s) under double patent rejection set forth in this Office action.

7. The following is a statement of reasons for the indication of allowable subject matter:

The present invention of claims 5 – 7, 18, 19, 21 – 24 and 27 - 35 is directed to a reproducing apparatus and method includes a reproducing unit to reproduce mainstream data and sub audio data separately added in the mainstream data, wherein the reproducing unit comprises a counter used in reproducing the sub audio data.

Independent claims 5 identifies the unique distinct feature “a sub audio reproducing unit to reproduce sub audio data separately added into the mainstream data, using a sub audio arrival time clock which is used to depacketize the sub audio data and is independent of the mainstream arrival time clock and a sub audio system time clock which is used to decode the depacketized sub audio data and is independent of the mainstream system time clock.”

The closet prior art, Kato et al (US 2002/0145702) discloses a mainstream

reproducing unit to reproduce mainstream data including still image data, using a mainstream arrival time clock which is used to depacketize the mainstream data and a mainstream system time clock which is used to decode the depacketized mainstream data (fig 96, paras 0435 to 0439 illustrates mainstream data depacketize and decode). Yoo et al (US 7366396) discloses two clock counters in recording apparatus but not in reproducing apparatus. However Kato et al and Yoo et al fail to anticipate or render the above mentioned underlined limitations obvious.

Hence claim 5 will be allowed.

Since claims 6 and 7 are dependent on claim 5, therefore they will also be allowed.

Independent claims 18 identifies the unique distinct feature “a second reproducer reproducing a second data stream based on second counters and the second counters comprise a second arrival time clock and second system time clock counter which are initialized based on program clock reference information in the first and second data.”

The closet prior art, Kato et al (US 2002/0145702) discloses a first reproducer reproducing a first data stream based on first counters wherein the first counters comprise a first a first system time clock counter (fig 96, paras 0435 to 0439 illustrates first system time clock counter). Yoo et al (US 7366396) discloses two clock counters in recording apparatus but not in reproducing apparatus. However Kato et al and Yoo et al fail to anticipate or render the above mentioned underlined limitations obvious.

Hence claim 18 will be allowed.

Since claims 19, 21 – 24 and 27 - 30 dependent on claim 18, therefore they will

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also be allowed.

Independent claims 31 identifies the unique distinct feature “sub audio data, which is separately added in the mainstream data, in the form of data packets, to be reproduced using a sub audio arrival time clock which is used to depacketize the sub audio data and is independent of the mainstream arrival time clock and a sub audio system time clock which is used to decode the depacketized sub audio data and is independent of the mainstream system time clock.”

Hence claim 31 will be allowed.

Independent claims 32 identifies the unique distinct feature “a second data stream in the form of data packets to be reproduced based on second counters and the second counters comprise a second arrival time clock and second system time clock counter included in the reproducing apparatus which are initialized based on program clock reference information in the first and second data stream.”

Hence claim 32 will be allowed.

Since claims 33 - 35 dependent on claim 32, therefore they will also be allowed.

Hence claim 5 – 7, 18, 19, 21 – 24 and 27 - 35 will be allowed over prior art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Nonomura et al (P.N. 2003/0108338) discloses optical disk, reproduction apparatus, reproduction method, and recording medium

Kashiwaga et al (US 6470460) discloses method and an apparatus for reproducing bit-stream having non-sequential system clock data seamlessly

there between

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED Y. HASAN whose telephone number is (571)270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H./
01/15/2010

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621